



CarIPI Opposition Proceedings webinar

Sophia Bonne, 24th January 2023



CARIFORUM



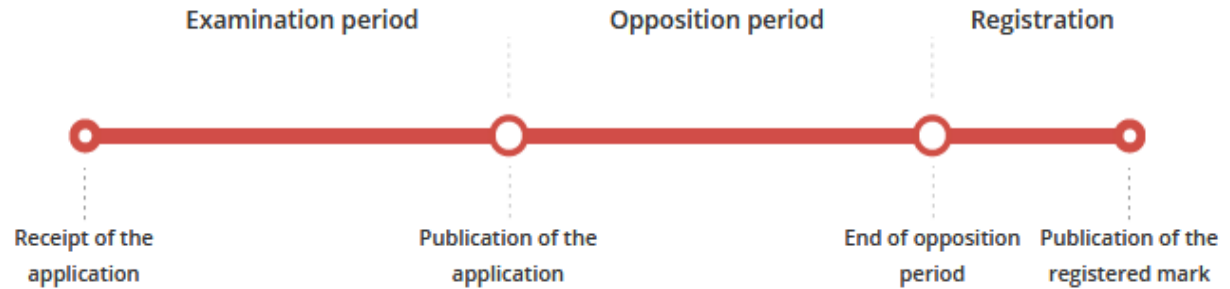
EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.caripi-hub.com

- Key features and timeline
- Legislative framework
- Identity
- Trade marks with reputation
- Short presentation of other grounds

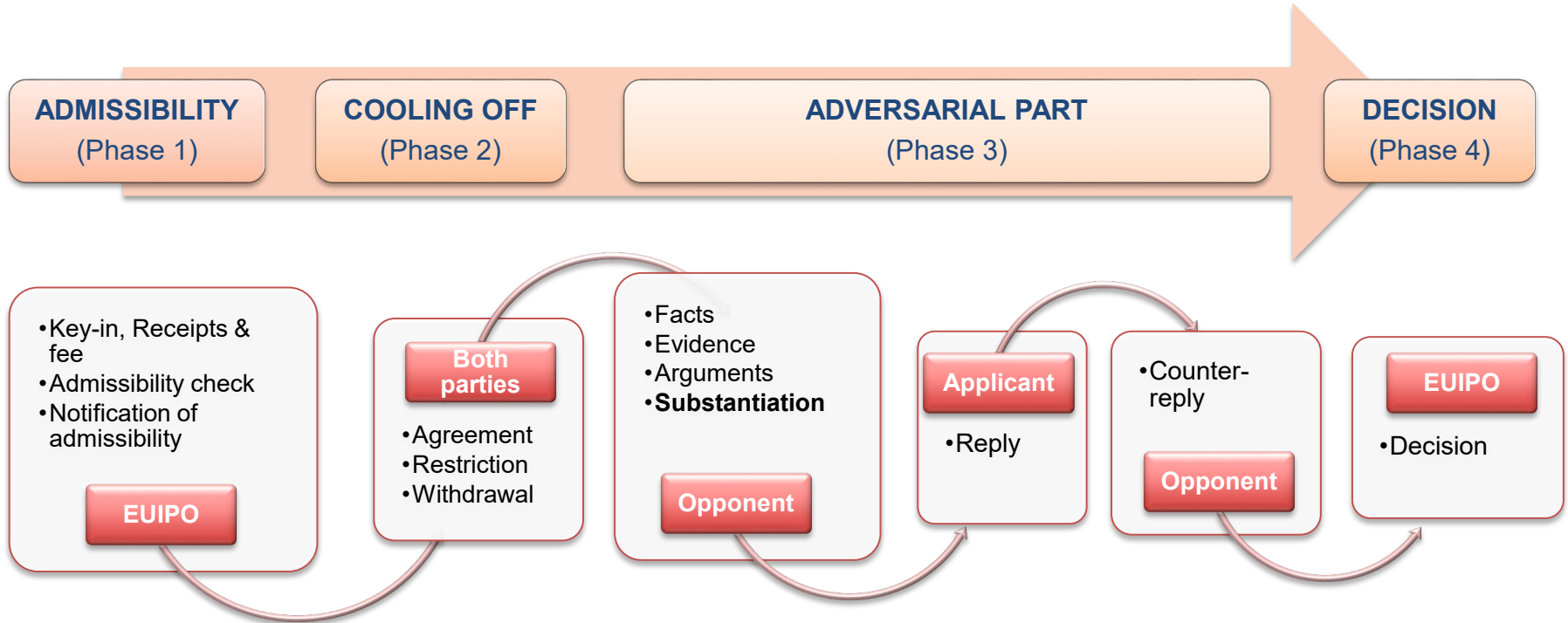
Key features

- Pre-registration procedure



- Not ex officio
 - Upon request
 - Limited to facts, evidence and arguments
- Inter partes
- 5 languages: DE, EN, ES, FR, IT

Timeline



Legislative framework on substance, Art. 8 EUTMR

- Art. 8(1) EUTMR - Double identity / Likelihood of confusion
- Art. 8(3) EUTMR - Unauthorised filing by agent/representative
- Art. 8(4) EUTMR - Unregistered marks and other signs used in the course of trade
- Art. 8(5) EUTMR - Marks with reputation
- Art. 8(6) EUTMR – Geographical indications

Earlier rights

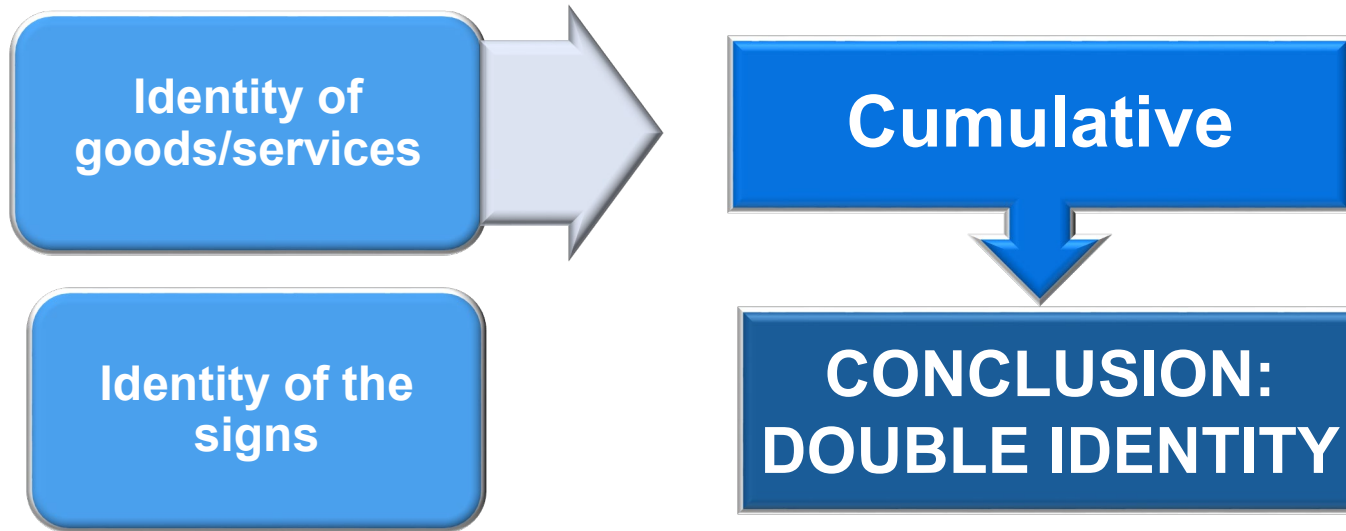
- Art. 8(1) EUTMR, Art. 8(5) EUTMR – applications or registered EUTMs, national TMs (EU member states), IR des. EU or member states plus well-known marks (Article 6bis of the Paris Convention).
- Art. 8(3) EUTMR – registered or unregistered trade marks , **not only EU**
- Art. 8(4) EUTMR - unregistered trade marks and other signs used in the course of trade **within EU**, like trade names, company names etc.
- Art. 8(6) EUTMR – Geographical indications protected in the EU

Art. 8 (1) EUTMR

Art. 8 (1) (a) EUTMR

- *Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:*
- *(a) if it is **identical** with the earlier trade mark and the goods or services for which registration is applied for are **identical** with the goods or services for which the earlier trade mark is protected;*

Art. 8 (1)(a) EUTMR – double identity



Art. 8 (1)(a) EUTMR – signs

- absolute protection by Art. 8(1)(a)
- concept of identity between trade marks must be interpreted strictly
- where it reproduces, **without any modification or addition**, all the elements constituting the trade mark **or**
- as a whole, it contains **differences so insignificant** that they may go unnoticed


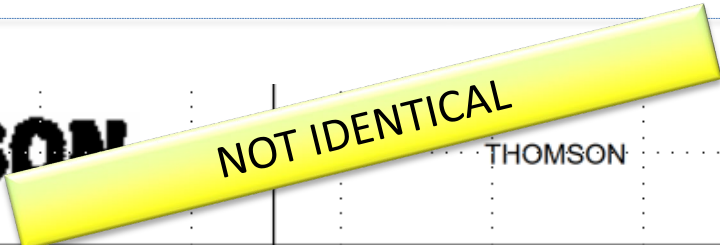




Art. 8 (1)(a) EUTMR

Apetito	APETITO	04/05/2011, T-129/09, EU:T:2011:193
ВАСИЛЪКИ	Васильки	31/01/2012, B 1 827 537
NOVALLOY	NOVALOY	17/12/1999, B 29 290
She, SHE	S-HE	23/09/2009, T-391/06, EU:T:2009:348

IDENTICAL

NOT IDENTICAL

Art. 8 (1)(a) EUTMR: signs





	 THOMSON	22/04/2009, R 252/2008-1
	 I thumbs up	12/04/2013, 7078 C
	 XTEP	28/02/2013, B 2 031 741

Convergence Programme 4 – common practice





- identity of earlier B&W/greyscale marks with their coloured versions
- the differences between an earlier B&W/greyscale mark and a coloured version of the same sign will normally **be noticed** by the average consumer – thus marks are **not considered identical**.
- **exceptional circumstances** that the signs will be considered identical, namely where the **differences in the colours** or in the **contrast of shades are so insignificant** that a reasonably observant consumer will perceive them only upon examining the marks side by side.
- <https://www.tmdn.org/network/scope-and-protection>

Convergence Programme 4 – common practice

Invented examples of significant differences with the consequence of no identity:

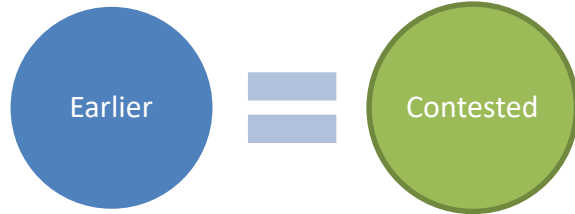
Earlier sign	Contested sign
	
	

Convergence Programme 4 – common practice

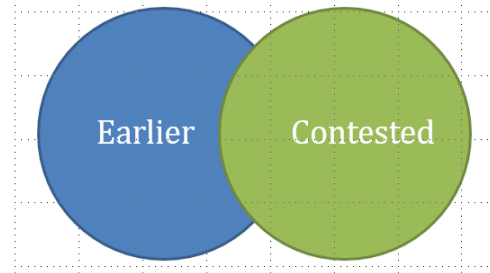
Earlier sign	Contested sign
	
	

IDENTICAL

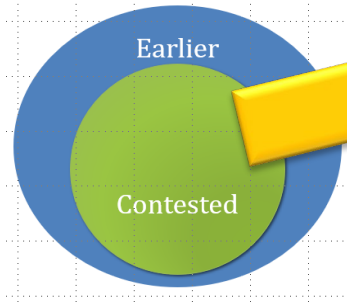
Art. 8 (1)(a) EUTMR: goods



FOOTWEAR = FOOTWEAR

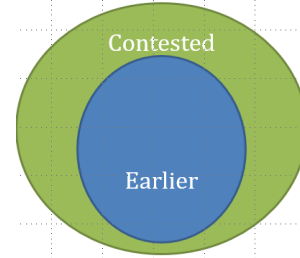


FOOTWEAR FOR KIDS v. FOOTWEAR FOR SPORTS
(FOOTWEAR FOR KIDS)



FOOTWEAR v. SPORTS FOOTWEAR

IDENTICAL



SPORTS FOOTWEAR v. FOOTWEAR

Art. 8 (1)(a) EUTMR - Double identity

Earlier mark:

DOMINION

*Class 9: Data processing
equipment and computers*

EUTM application:

DOMINION

*Class 9: Serial console servers
for KVM (KVM being an
abbreviation for 'keyboard,
video and mouse') switches.*

R0098/2011-2

Decision:

- **SIGNS:** Identical
- **GOODS:** Identical
- **CONCLUSION:** Double Identity

Art. 8 (1)(a) EUTMR - Double identity

Earlier mark:

BIG BROTHER

Class 25: Clothing, footwear and headgear

EUTM application:



Class 25: Clothing, footwear, headgear.

R0932/2010-4

Decision:

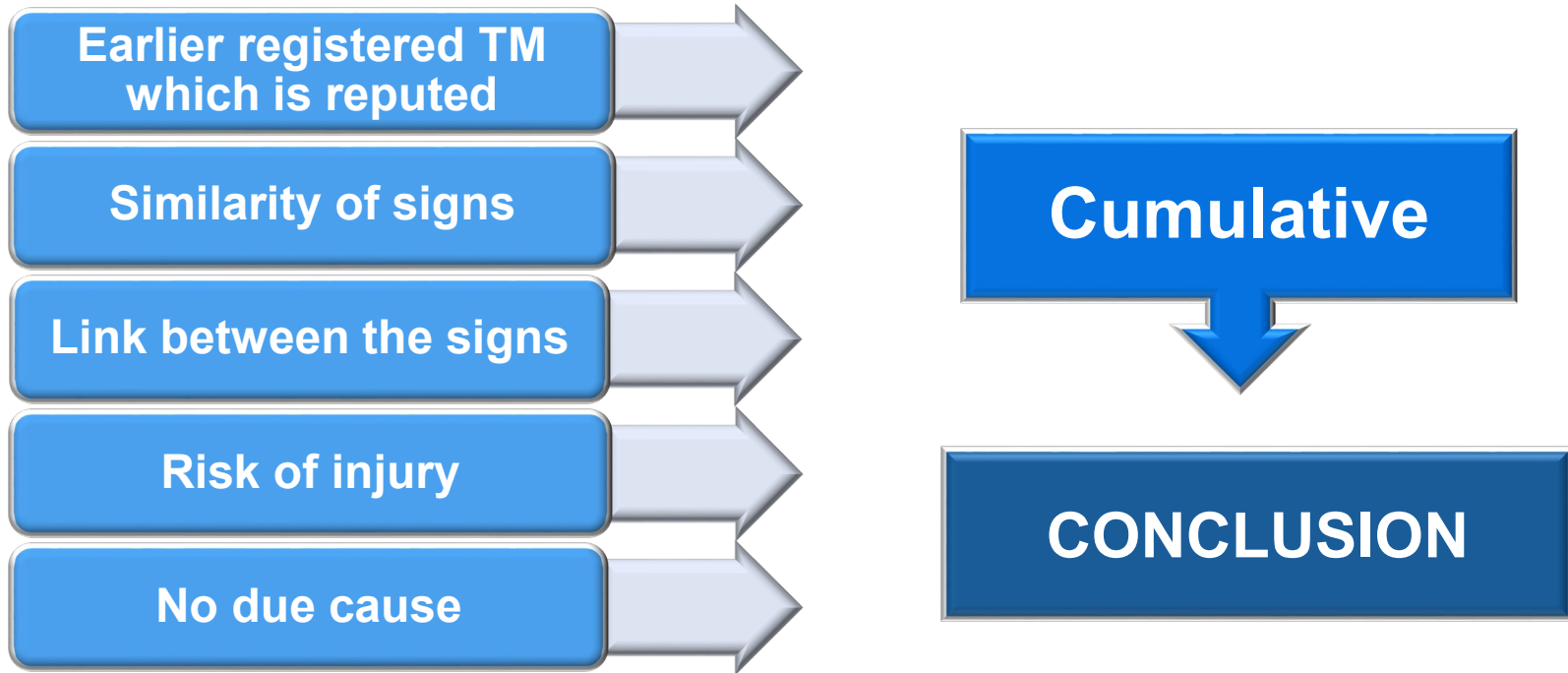
- **SIGNS:** Similar
- **GOODS:** Identical
- **CONCLUSION:** **No Double Identity**

Art. 8 (5) EUTMR – trade marks with reputation

Art. 8 (5) EUTMR

*Upon opposition by the proprietor of a **registered earlier trade mark** within the meaning of paragraph 2, the trade mark applied for shall not be registered where **it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.***

Art. 8(5) EUTMR



Art. 8 (5) EUTMR – reputation

- degree of knowledge – by significant part of the public (market share, intensity, duration, geog. extent, investment)
- in a substantial part of the territory of the MS/part of EU
- before the date of priority of the contested mark
- for the relevant goods and services

Art. 8 (5) EUTMR – reputation evidence

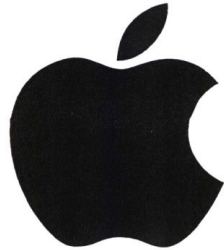
- company profiles, annual reports, affidavits
- market surveys
- ranking, recognitions, awards, press articles
- statements from third parties
- sales turnover, market share
- invoices, delivery notes
- advertising expenditure, advertising and promotional material
- sponsorship of cultural, sports events, merchandising
- previous national court/EUIPO/CJ decisions, successful enforcement track record

Art. 8 (5) EUTMR – link between the signs – factors

- **similarity of signs** (not to the point of confusion, but only to the extent that the contested mark calls the earlier reputed mark to mind)
- **degree of reputation**
- **overlap of public**
- **proximity of the market sectors** (classic tests for assessing similarity of g and s will not help to find the necessary connection between otherwise dissimilar g and s!)
- **inherent distinctiveness** of the earlier mark (particularly for dilution!)

Art. 8 (5) EUTMR – similarity of signs

- the method of assessment is the same as in Article 8(1)(b) EUTMR
- the standard of similarity is not the same
- a similarity which may not be sufficient to lead to a likelihood of confusion under Article 8(1)(b) EUTMR may be sufficient to bring the earlier reputed mark to mind
- but if there is no similarity at all, there can be no infringement
- reputation has no impact on similarity of signs



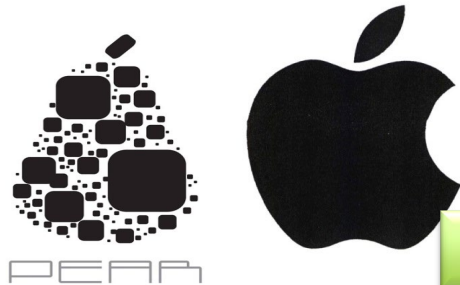
Classes 9, 35 and 42

Visual comparison



- -Depiction of different fruits;
- -Shapes for figurative elements dissimilar (“stem” vs. “leaf”);
- -Pear depicted as a compilation of many rounded squares of different sizes, apple one solid image;
- -“bite” (apple) vs. no bite (pear)
- -Word element (“pear”) vs. no word element

Visually Dissimilar



Classes 9, 35 and 42

Conceptual comparison

The common element – both concern fruits, albeit different fruits.

DISSIMILAR

with a leaf

- Full fruit vs bitten fruit
- Stem vs leaf

The mere existence of a generic term, under which both concepts fall, does not make them similar

Conceptually Dissimilar



Opposition Proceedings: Art. 8 (5) EUTMR – types of injury

- **misappropriation of its attractive** powers or an exploitation of its image and prestige (unfair advantage of the distinctive character or repute- **free-riding**), or
- **diminishing its capacity to arouse immediate association** with the goods and services of the reputed mark (detriment to distinctive character - **dilution**), or
- **devaluing the image** it has acquired among the public (detriment to repute - **tarnishment**), or

Art. 8 (5) EUTMR free riding

BEATLES

sound records, video records and films

BEATLE

wheelchairs and other disability equipment

‘take unfair advantage of the reputation and ‘image of freedom, youth and mobility’ with which the earlier mark ‘Beatles’ is associated in the field of ‘sound records, video records, films’ (see judgment of 29/03/2012, T-369/10, ‘Beatle’).

SPA

mineral water

SPA-FINDERS

publications, catalogues, magazines, newsletters, travel agency services

‘no evidence of unfair advantage or any kind of exploitation of the fame of the earlier mark. The word SPA in the mark applied for only denotes the kind of publication concerned. (see judgment of 25/05/2005, T-67/04, ‘Spa-Finders’)

Opposition Proceedings: Art. 8 (5) EUTMR dilution

SPA

mineral water

SPA-FINDERS

publications, catalogues, magazines, newsletters, travel agency services

The term 'spa' in SPA-FINDERS may be used otherwise than in a trade mark context since it 'is frequently used to designate, for example, the Belgian town of Spa and the Belgian racing circuit of Spa-Francorchamps or, in general, places for hydrotherapy such as hammams or saunas, [and consequently] the risk of detriment to the distinctive character of the mark SPA seems to be limited (see judgment of 25/05/2005, T-67/04, 'Spa-Finders')

BOTOX

*pharmaceutical preparations
for the treatment of wrinkles*

BOTUMAX

*cosmetic and household cleaning products;
dietetic substances, food for babies, plasters, etc;
printed matters, instructional and teaching material*

The word 'Botox' is a fanciful term by which the goods covered by the reputed mark are known. The use of a similar word for the goods in classes 3, 5 and 16 will result in the dilution of the distinctive character of the earlier mark. (see judgment of 28/10/2010, T-131/09, 'Botumax')

Opposition Proceedings: Art. 8 (5) EUTMR tarnishment

EMILIO PUCCI

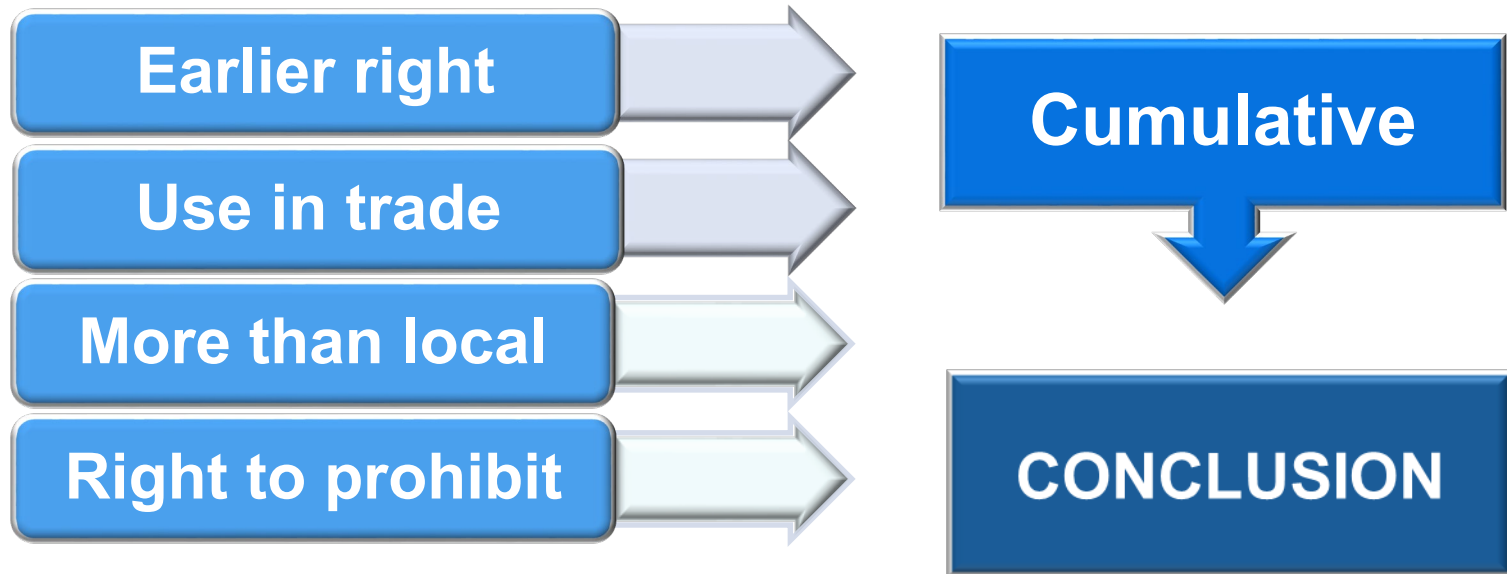
clothes and shoes for women

Emidio Tucci

non-perfumed toilet paper

The Court held that use of the sign ‘Emidio Tucci’ in respect of toilet paper is likely to cause undesired and negative associations with the earlier mark ‘Emilio Pucci’ which has acquired reputation in the luxury clothing sector. (see judgment of 27/09/2012, T-357/09, ‘Emidio Tucci’, paragraphs 85, 86).

**Art. 8 (4) EUTMR – unregistered trade marks,
signs etc.**



Art. 8 (4) EUTMR R2135/2016-2, T-671/17

Earlier **unregistered mark** under the
law of **passing off** (UK):



TURBO-K

Used for: gas turbine compressor
cleaner

EUTM application:

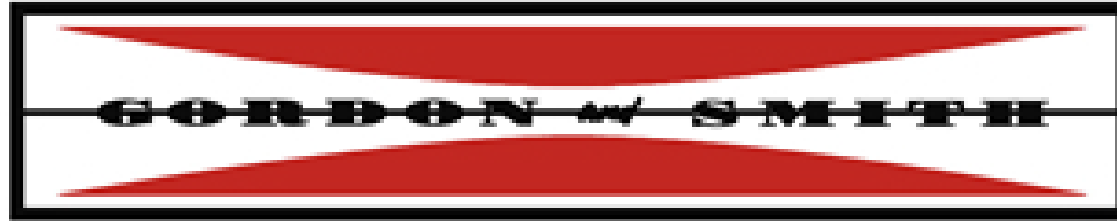
TURBO-K

Goods in classes 1 and 3,
services in Class 35

EUTM partially refused

- ✓ Earlier non registered trade mark used in trade in the UK
- ✓ Use of more than mere local significance
- ✓ Under UK law, owner can prohibit use
- ✓ Conditions of passing off (Goodwill, Misrepresentation, Damage)

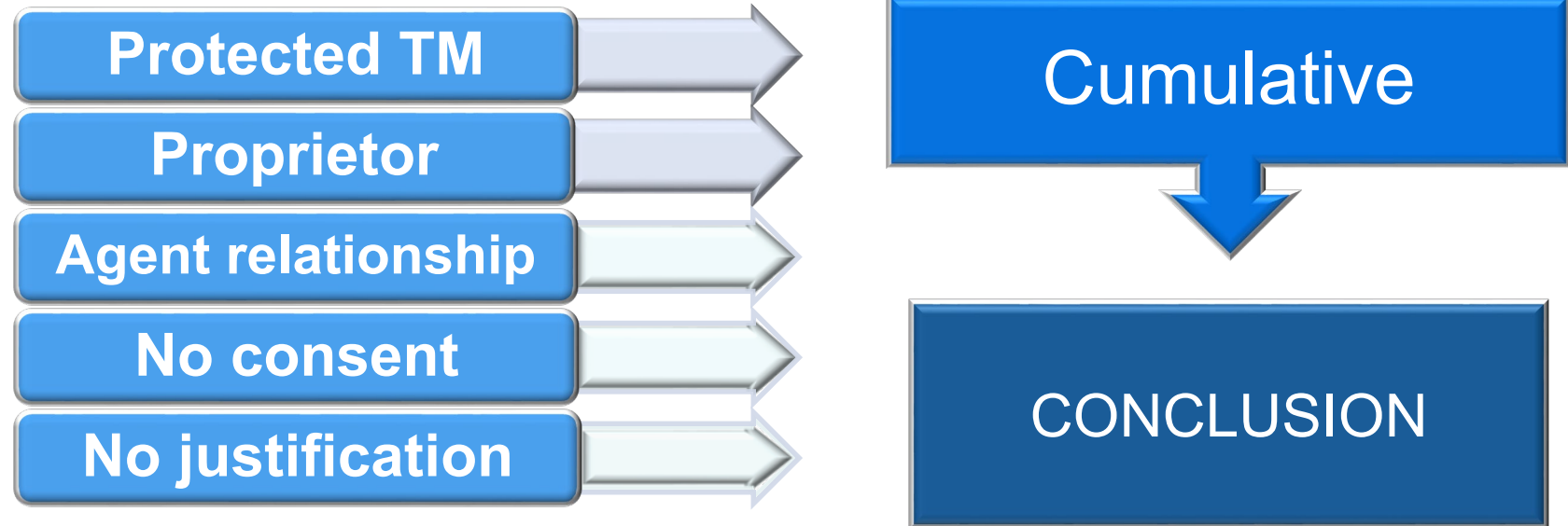
Art. 8 (3) EUTMR – unauthorised filing by an agent



Class 25 – Articles of clothing, footwear and headgear

Class 28 – Articles for gymnastics and sport

Opposition Proceedings: Art. 8 (3) EUTMR





THANK YOU
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